

30 JAN 2003

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 23
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Venator Group Retail, Inc
v.
L.M. McCullough and J. Pryor

Opposition No. 118,753
to application Serial No. 75/743,947
filed on July 6, 1999

Marie-Anne Mastrovito of Abelman, Frayne & Schwab for
Venator Group Retail, Inc.

Charles R. Sutton for L.M. McCullough and J. Pryor.

Before Cissel, Walters and Chapman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 6, 1999, applicant, a partnership under California law, filed the above-referenced application to register the mark "ANKLE LOCKER" on the Principal Register for what were subsequently identified by amendment as "money belts to be worn around the ankle or wrist," in Class 25. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark on or in connection with these goods in commerce.

Applicant disclaimed the word "ANKLE" apart from the mark as shown.

On May 10, 2000, Venator Group Retail, Inc. filed a timely Notice of Opposition. As grounds for opposition, opposer asserted prior use and registration of the mark "FOOT LOCKER" in connection with duffel bags, knapsacks, and hip packs;¹ athletic wear, namely, warm-up suits, jackets, t-shirts, sweatshirts, football jerseys and tennis outfits, racquet covers;² and prior use and registration of a stylized presentation of the word "FOOT LOCKER" for retail sports apparel and footwear store services;³ and for men's, women's and children's shoes and hosiery.⁴ Opposer pleaded that the mark applicant seeks to register, if applied to the goods specified in the application, as amended, would so resemble opposer's prior-used and registered marks that confusion would be likely. Opposer also pleaded that applicant's mark would falsely suggest a connection with opposer within the proscription of Section 2(a) of the Lanham Act because applicant's mark is a close approximation

¹ Reg. No. 1,713,673 issued on the Principal Register on September 8, 1992; Affidavits under Sections 8 and 15 accepted and acknowledged.

² Reg. No. 1,126,857 issued on the Principal Register on November 20, 1979; Affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

³ Reg.No. 1, 032,592 issued on the Principal Register on February 3, 1976; Affidavits under Sections 8 and 15 received and accepted; Renewed.

⁴ Reg.No. 1,061,754 issued on the Principal Register on March 22, 1977; Affidavits under Sections 8 and 15 accepted and acknowledged; Renewed.

of the previously used name or identity of opposer, opposer is not connected with the goods to be sold by applicant under applicant's mark, and opposer's name or identity is of sufficient fame or reputation that applicant's use would result in an association with opposer. As a third ground for opposition, opposer pleaded that opposer's mark is a famous mark under section 43(c) of the Lanham Act, and that applicant's use of the mark it seeks to register would cause dilution of the distinctive quality of opposer's mark.

Applicant moved to dismiss the opposition, but the Board denied the motion. Applicant then filed its answer to the Notice of Opposition, denying the essential allegations therein.

A trial was conducted in accordance with the Trademark Rules of Practice. Neither party, however, took testimony in this case. Opposer introduced, by Notice of Reliance, the four registrations pleaded in the Notice of Opposition, as well as applicant's responses to ten interrogatories and six requests for admission. Applicant introduced, also by Notice of Reliance, the file wrappers of opposer's pleaded registrations, as well as opposer's responses to twenty-three of applicant's requests for admission.

Both parties filed briefs and opposer filed a reply

brief,⁵ but neither party requested an oral hearing before the Board. Accordingly, we have resolved this proceeding based on the written record and arguments provided by the parties.

Based on careful consideration of these materials, we find that opposer has failed to meet its burden of establishing that confusion would be likely under Section 2(d) of the Act; that applicant's mark falsely suggests a connection with opposer under Section 2(a) of the Act; or that applicant's mark would cause dilution of opposer's mark within the meaning of Section 43 of the Act. Simply put, opposer, as plaintiff in this proceeding, had the burden of proof, but failed to support its claims with sufficient evidence to prevail.

Turning first to the claim of likelihood of confusion, we note that our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely in the case of *In re E. I duPont de Nemours Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the marks as

⁵Applicant moved to strike opposer's trial brief because the table of cases for the brief was submitted one day after the brief was timely submitted, but one day after the brief was due. This caused very little delay and virtually no hardship on applicant. Our objective is to resolve disputes before us on their merits. Opposer's oversight was rectified promptly. Applicant was not damaged thereby. Applicant's motion to strike is therefore denied, as is applicant's request that the Board consider opposer to have abandoned the opposition by not filing the table of cases with its brief.

to appearance, sound, meaning and commercial impression, and the similarity of the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In the case before us, opposer has not established that the marks are so similar that their use in connection with the products and services identified in the pleaded registrations and the application, respectively, would be likely to lead to confusion. To the contrary, these marks have significant differences in appearance, sound, meaning and commercial impression in connection with the respective goods and services of the parties.

Notwithstanding opposer's argument that the marks are similar because both marks include the word "LOCKER" combined with either "FOOT" or "ANKLE," which are closely related body parts, the mark applicant seeks to register, as applied to the goods specified in the application, creates a different commercial impression from that which is created by opposer's mark in connection with the goods and services set forth in the registrations. We agree with applicant that applicant's mark is a coined term which suggests that applicant's money belts are devices used to store small items such as money, cards or keys by attaching the device to the ankle. The term "foot locker, in contrast, is a common term with a recognized meaning as "a small trunk

designed to be placed at the foot of a bed (as in a barracks)."⁶ In connection with the footwear and other apparel items for which opposer has registered this mark, as well as in connection with opposer's retail store services featuring these products, opposer's mark connotes a place where shoes and clothing are stored, rather than the portable container worn on the ankle or wrist which applicant intends to market under its mark. Both marks do include the term "LOCKER," but consumers know what a footlocker is, whereas "ANKLE LOCKER" is a coined term which only takes on meaning when it is considered in connection with applicant's goods. The marks do not look alike, sound alike, or have similar meanings. The commercial impressions engendered by them in connection with the goods and services of the parties are so different that confusion would not be likely, so opposer's claim under Section 2(d) must be denied.

This conclusion might be different if opposer had established that its mark is famous, but opposer did not present any evidence in support of this claim. Opposer's assertion that its mark is famous simply because it has been registered for a long time falls far short of what is required to establish fame. Opposer provided no evidence that the use and promotion of the registered marks has been

⁶ Webster's Ninth New Collegiate Dictionary, of which the Board hereby takes judicial notice.

of sufficient nature and amount that the purchasing public regards these marks as even well known, much less famous. See *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 67 USPQ2d 1303 (Fed. Cir. 2003). Applicant acknowledged that "the word FOOT LOCKER has been around" for a long time, and that when the partners in applicant were children, they shopped at "FOOT LOCKER" stores for sneakers or athletic apparel, (response to Interrogatory 6, Exhibit E), but this admission is hardly a concession that opposer's mark has achieved fame within the meaning of the *du Pont* case, *supra*. Opposer's argument that "Opposer's Mark has similarly been widely recognized by consumers throughout the nation for several decades" (brief, p. 10) is simply conjecture, unsupported by any evidence.

Additionally, nothing in the record supports opposer's contention that the goods specified in the application are closely related to the goods or services set forth in opposer's pleaded registrations. Opposer argues that applicant's money belts worn around the ankle or the wrist will be the kind of item sold in opposer's type of retail stores to people who also purchase athletic clothing and shoes, but nothing in the materials made of record by opposer supports this conclusion. Applicant concedes that its products will be used by runners and other athletes who do not have pockets in which to store small items like money

or keys, but we have no evidence that such people would have any basis upon which to assume that a single source would be responsible for this kind of money belt, on the one hand, and for the goods and services related to shoes and clothing that are set forth in opposer's pleaded registrations, on the other. Further, this record does not contain any evidence in support of opposer's argument that consumers would have any basis for believing that applicant's mark would be an indication that opposer has expanded its use of its marks to include the goods to be sold by applicant under the mark it seeks to register.

In a similar sense, opposer failed to meet its burden of proof with respect to its claim under Section 2(a) of the Act that applicant's mark would create the false suggestion of a connection with opposer. The pleading in the Notice of Opposition hinted that opposer was aware of the need to establish several facts in order to prevail on this claim, but this record does not provide any basis upon which we could conclude that applicant's mark is the same as or a close approximation of opposer's name or identity; that the mark would be recognized as such by purchasers, i.e., that it points uniquely and unmistakably to opposer's persona or identity; or that opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on its goods, a connection with opposer would be

presumed. See *In re Kayser-Roth Corp.*, 29 USPQ2d 1379 (TTAB 1993); and *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985). Accordingly, opposer's claim under Section 2(a) must fail.

We thus turn to the final claim pleaded by opposer, that under Section 43(c) of the Lanham Act, the use of applicant's mark would cause dilution of the distinctive quality of opposer's famous mark. As noted above, opposer made of record no evidence on which the conclusion that its mark is famous could be based. In a similar sense, we have not been presented with any evidence demonstrating that the use of applicant's mark would cause the dilution of opposer's mark. Counsel for opposer argues in her brief that "consumers will immediately associate the Applicant's Mark with Opposer's famous trademark and therefore, ANKLE LOCKER will weaken the strength of the mark FOOT LOCKER," but the record provides no support for her legal conclusion in this regard. See *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001).

We note for the record that applicant's arguments with regard to the use of other marks by third parties and equitable estoppel based thereon are not the basis for our conclusions on the merits of this proceeding. If the evidence on which these arguments is predicated shows anything, it is that opposer has actively attempted to

assert its rights against businesses which opposer perceived to be using marks which might damage opposer. Applicant has introduced no evidence of actual use of similar marks by others in opposer's field.

In summary, on this record, opposer has not met its burden of proof in establishing that confusion would be likely under Section 2(d) of the Act; that applicant's mark would falsely suggest a connection with opposer under Section 2(a) of the Act; or that applicant's mark would dilute the distinctive quality of opposer's famous mark under Section 43(c) of the Act.

DECISION: The opposition is dismissed.